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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,563	11/20/2000	John B. Ferber	2580-003	7535
22852	7590	11/12/2004	EXAMINER CHAMPAGNE, DONALD	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			ART UNIT 2121	PAPER NUMBER

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,563

Applicant(s)

FERBER, JOHN B.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's request for reconsideration filed on 29 October 2004 noted correctly that some arguments filed on 10 May 2004 had not been addressed. These arguments are addressed below in para. 5 and 7.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Bezos et al.
4. Bezos et al. teaches (independent claims 1 and 7) a method and system for e-mail-based opt-in marketing, and for encouraging consumers and webmasters for participating in said marketing program, the method comprising: providing a *Web server 132*, which reads on an ad server and at least one webmaster server connected to the Internet, and having at least one *associate computer 200* (internet-enabled subscriber device) connected to said Internet (col. 9 lines 54-61 including Fig. 2); providing an *associate database 160* connected to said ad server/*Web server 132* (col. 10 line 45); providing software instructions on each said webmaster server for collecting an e-mail address for said subscriber device and storing said e-mail address on said database *160* by having an operator of said subscriber device input said e-mail address and make a selection to opt-in for delivery of information and/or content to said e-mail address (col. 10 lines 11-15 and 41-45); and providing software instructions on said ad server to facilitate delivery of said information and/or content to said *associate computer 200*/subscriber device, wherein said information and/or content includes descriptions of the merchant and its products, which reads on an ad (col. 10 lines 50-55).

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5. Applicant argues (p. 3, indented para.) that the reference fails to teach the last two limitations of claim 1. In detail, the teaching is as follows. Col. 10 line 42 teaches software instructions on each said webmaster server for collecting an e-mail address for said subscriber device and storing said e-mail address on said database **160** by having an operator of said subscriber device input said e-mail address and make a selection to opt-in for delivery of information and/or content to said e-mail address. Col. 10 lines 53-54 teach detailed information about setting up an associate's website, which reads on providing software instructions on said ad server to facilitate delivery of said information and/or content to said *associate computer 200*/subscriber device, wherein said information and/or content includes descriptions of the merchant and its products, which reads on an ad.
6. Note that an *associate* may be a consumer or a webmaster. Hence, Bezos et al. also teaches (independent claims 13 and 17): providing software to said *associate/consumer/webmaster* to allow said *associate/consumer/webmaster* to refer other consumers/webmasters to said e-mail marketing program as referrals (col. 1 lines 62-66); and providing compensation to said *associate/consumer/webmaster* for any referrals (col. 3 lines 19-21), where the compensation also reads on an incentive provided to said *associate/consumer* to responding to ads (by making purchases), and also reads on an incentive provided to said *associate/webmaster* for subscribing other *associates/webmasters* to said e-mail marketing program.
7. Applicant argues (pp. 3-4) that the reference fails to teach two limitations of claim 13. The two limitations do not differ materially from those at issue in claim 1 and discussed in para. 4-5 above.
8. Bezos et al. also teaches at the citations given above claims 2, 4-6, 8, 10-12, 16 and 19. Bezos et al. also teaches claims 3, 9, 14, 15 and 18 (col. 7 line 50).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of

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the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
10. The examiner's supervisor, Anthony Knight, can be reached on 571-272-3687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-930606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
11. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
12. Applicant may have after final arguments considered and amendments entered by filing an RCE.
13. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their

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registration information including telephone number at the Office's web site, www.uspto.gov.

At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

8 November 2004

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'DL Champagne', written over a horizontal line.

Donald L. Champagne
Primary Examiner
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